



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/617,580

07/11/2003

Thomas L. Foster

10922/51

3677

757 7590 07/21/2008
BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

EXAMINER

NGUYEN, TUAN VAN

ART UNIT

PAPER NUMBER

3731

MAIL DATE

DELIVERY MODE

07/21/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/617,580	Applicant(s) FOSTER ET AL.	
	Examiner TUAN V. NGUYEN	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-11,13-17,20-23 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) 9,23 and 27-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-8,10,11,13-17,20-22,25 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In previous Office action, claims 1-8, 10-22 and 24-26 were examined and rejected. Claims 9, 23, and 27-29 have been withdrawn from further consideration as being drawn to nonelected inventions.

Response to Amendment

2. According to the amendment filed on April 10, 2008, claims 3, 4, 12, 18, 19 and 24 have been canceled. Accordingly, claims 1, 2, 5-8, 10-11, 13-17, 20-22 and 25-26 are presented for examination.
3. Applicant's arguments filed on April 10, 2008 with respect to the rejection of claims 1, 2, 5-8, 10-11, 13-17, 20-22 and 25-26 under 35 USC § 102 and 103 have been fully considered but they are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. **Claims 1, 2, 5-8, 10-11, 13-17, 20-22 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foster et al. (US 6,500,182) in view of Jones et al (U.S. 5,843,050).**
7. Foster discloses (Figs. 1 and 8) a medical retrieval device 10 is disclosed comprising an elongated cylindrical member 11 that includes a continuum of a material 40, preferably a metal such as stainless steel or nitinol, that forms both the resilient grasping members 13 of retrieval basket 54, snare 26, or grasper forceps 23, and the proximal portion 21 or shaft of the device. An external constraining device 14, such as an outer sheath. Foster also discloses the retrieval devices of the present invention can fit through the accessory channel 46 of a small endoscope, such as an ureteroscope 44 while still having a sufficient lumen size to accommodate an ancillary treatment device 25 such as a standard 200 micron laser fiber or lithotripsy wire and irrigation system (Abstract; col. 4, line 50 to col. 5, line 10; and col. 7, lines 5-25). Foster discloses the invention substantially as claimed except for the distal portion which comprises a spiral cut along a longitudinal axis of the cannula 11. However, Jones discloses (see Fig. 3) a microcatheter 10 having tubular element 30 wherein a distal portion of tubular 30 includes at least two sections with spiral cut wherein spiral cut of each section

having different pitch to provide a high degree of flexibility to facilitate negotiation of small, tortuous vessels (see Abstract and col. 5, lines 1-40). It would have been obvious to one of ordinary skill in the art to incorporate the spiral cut, as disclosed by Jones, into the distal portion of the cannula of Foster so that it too would have the same advantage.

8. Referring to claims **2, 5, 6, 16, 17, 22, and 25-26**, Foster as modified by Jones discloses the invention substantially as claimed except for specifically disclosing the dimensions that claimed by the applicant. It would have been obvious to one having ordinary skill in the art to design the spiral cut is taken about 60 to about 80 degrees from the longitudinal axis of the cannula and the width of the spiral cut is about 0.001 to about 0.002 inches wide, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. Extrinsic evidence, Pinchuk (US 4,960,410) discloses spiral cut is taken about 25 to about 85 degrees from the longitudinal axis of the cannula (see col. 3, lines 58-60).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUAN V. NGUYEN whose telephone number is (571)272-5962. The examiner can normally be reached on M-F: 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/T. V. N./

Examiner, Art Unit 3731

Application/Control Number:
10/617,580
Art Unit: 3731

Page 6

/Todd E Manahan/

Supervisory Patent Examiner, Art Unit 3731